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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/628,146 07/28/00 DI PRINZIO N 102

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QM32/1010

EXAMINER

THURSTON, A

ART UNIT

PAPER NUMBER

3722

DATE MAILED:

10/10/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/628,146

Applicant(s)
Di Prinzio

Examiner
Allsa L. THURSTON

Group Art Unit
3722



☒ Responsive to communication(s) filed on Jul 28, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-19 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-19 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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10. Claims 1-6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin US Patent No. 2,448,611. Martin discloses the claimed invention including a magnetic clip marker for use in engaging and marking a page including a pair of aligned rectangular wall members aligned at one end to define a throat with a base portion and a clip portion overlapping the base portion to define a throat therebetween and structurally arranged to receive a page of a book between the base and the clip portions with magnetic members (10) aligned with respect to one another and mounted to the base and a cover member (12 and 8) covering the magnetic members on the overlapping and substantially aligned portions to permit the book to be received in the throat (24) of the clip, where the cover members cover the magnetic member and the surrounding surface of the overlapping base and clip portion..

Martin also discloses one of the surfaces providing a surface for graphic prints or an embossment (see column 1, lines 40-42) and a signaling tab member (16) extending outwardly from the joined pair of wall members with guiding means (18) for admission of the edge of the page into the throat and one of the surfaces opposite the throat opening including an outer cover member and including wedge members (14) cooperating with the magnetic members.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 6, 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin US Patent No. 2,448,611. Martin discloses the claimed invention as set forth above except for the clip being made of plastic or cellulosic material and the wall members being circular and the surface opposite the throat opening including an electronic information display device.

It would have been obvious to one having ordinary skill in the art at the time the invention was made for the clip being made of plastic or cellulosic material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331 and it would have been an obvious matter of design choice to make the wall members being circular or whatever form or shape was desired. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

13. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin US Patent No. 2,448,611 in view of Johnson US Patent No. 2,630,777.

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Martin discloses the claimed invention as set forth above except for at least one of the edges of the wall members is traverse to the junction therebetween to form a line signaling member on the page of the book and an ornamental opening to provide a line identification on a line of the book and one of the base portion and the clip portion has a length greater than the other. Johnson teaches a clip mark with at least one of the edges of the wall members is traverse (21) to the junction there between to form a line signaling member on the page of the book and an ornamental opening (12) to provide a line identification on a line of the book and one of the base portion and the clip portion has a lenght greater than the other (15 and 18). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Martin's clip to have at least one of the edges of the wall members is traverse to the junction therebetween and one of the base portion and the clip portion has a lenght greater than the other, as taught by Johnson in order to form a line signaling member on the page of the book and secure and neat means for using the mark on a page.

14. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin US Patent No. 2,448,611 in view of Schwartz US Patent No. 5,380,043. Martin discloses the claimed invention as set forth above except for the surface opposite the throat opening including an electronic information display device. Schwartz teaches the use of the surface on a clip marker (see Figure 22 and column 8, lines 60-68) having electronic information recording device (see column 4, lines 1-10). It would have been obvious to one of ordinary skill in the art at the time

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the invention was made to modify Martin to include an electronic device as taught by Schwartz and to make the device a display device to allow the user to view information recorded into the device.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

16. In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXING of responses to Office Actions directly into the Group at (703) 305-3579.

Transmissions can be received from the Applicant at all times. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. The faxing of such documents must conform with the notice published in the official Gazette, 1096 OG 30 (October 19, 1998).

Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 3720 will be promptly forwarded to the Examiner. Applicant is reminded to clearly mark any transmissions as "DRAFT" if it is not to be considered as an official response.

17. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Alisa Thurston whose telephone number is (703) 305-1645. The examiner


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can normally be reached on Monday-Friday from 7:00 am to 4:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, A. L. Wellington, can be reached on (703) 308-2159.

Any inquire of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.

ALT

September 30, 2000


A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

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Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the electronic information display device attached thereto must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. How the electronic information display device is attached and how it functions is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 11 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 11 recites the limitation "said junction therebetween" in line 3. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 15 recites the limitation "said throat opening" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.